

Application No. 09/683,329

**REMARKS**

Applicants thank the Examiner for the detailed Office Action included specific recitations and analyses of relevant sections of the references.

The Examiner has objected to the specification because of reference numerals. Applicants have corrected the relevant of the specification.

The Examiner has rejected the claims as being indefinite, stating that it is unclear from the claims whether the first and second features are for that edge cutting or lap joint patterns. The Examiner has asked for clarification, and the applicants refer the Examiner to the specification, which describes the invention in terms of lap joints.

With regard to the obviousness type double patenting rejections, applicants will submit terminal disclaimers upon receipt of the noticeable of allowability.

All instant claims in the case were rejected under 35 U.S.C. § 103 relying upon U.S. Patent Nos. 6,436,502 and 5,997,974, as well as U.S. Patents Nos. 6,318,223 and 5,942,301. Applicants traverse this rejection inasmuch, as the Examiner notes, the more recent reference is available only as a § 102(e) type reference. With regard to applied references U.S. Patents Nos. 6,436,502 and 6,318,223, the present application was filed on 14 December 2001 and claims benefit of the provisional application No. 60/256,154, filed on 15 December 2000. These dates are after the 29 November 2000 effective date of the amendment of 35 U.S.C. § 103(c), which eliminated 102(e)/103 rejections against subject applications filed or refiled after that date. Note 35 U.S.C. § 103(c), the PTO OG notice of 26 December 2000 (1241 OG 96) and M.P.E.P. § 706.02(L)(2) thereon. These references and the present application are commonly owned (on their face, and of record).

Application No. 09/683,329

The undersigned patent attorney hereby provides the simple statement that M.P.E.P. § 706.02(L)(2), p. 700-39, states is all that is necessary to remove such a 35 USC §103(c) reference. Namely, that: "the application and the references were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person."

All instant claims in the case were also rejected under 35 U.S.C. § 103 relying upon U.S. Patent Nos. 5,997,974 and 5,688,355, as well as U.S. Patents Nos. 6,318,223 and 5,942,301. Applicants traverse this rejection, as well. As noted above, the effective filing date of this application is 15 December 2000, 6,318,223 and the instant application are commonly owned, and 6,318,223 is thus disqualified as a reference. The Examiner has listed features of the various references that independently do appear to teach features of the instant claims. However, the Examiner concludes his rejection with a simple conclusory paragraph stating that it would have been obvious to combine these things to obtain applicants claims. Such conclusory paragraphs without evidence of a suggestion or motivation to combine are not permitted. See *In re Fine*, 837 F.2d, *In re Jones*, 958 F.2d 347, and *In re Lee*, Fed. Cir., No. 00-1158, 18 January 2002, for example. Since no such evidence has been presented, this rejection is improper and should be withdrawn.

In *In re Fine*, 837 F.2d 1071 at 1074, the CAFC states:

The primary basis for the Board's affirmance of the Examiner's rejection was that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide detector in the Eads system. The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art," but neither of them offered any support for or explanation of this conclusion. [boldface emphasis added]

and later, at 1075:

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* Here, the prior art contains none. [boldface emphasis added]

Application No. 09/683,329

Instead, the Examiner relies on hindsight in reaching his obviousness determination. But this court has the, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." [boldface emphasis added] *W.L. Gore*, 721 F.2d at 1553, 220 USPQ at 312-13. It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. [boldface emphasis added]

See also *In re Jones*, 958 F.2d 347 at 351, where the CAFC states:

Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed 2-(2'-aminoethoxy)ethanol salt. [boldface emphasis added] See *Grabiak*, 769 F.2d at 731-32, 226 USPQ at 872 ("In the case before us there must be adequate support in the prior art for the [prior art] ester/[claimed] thioester change in structure, in order to complete the PTO's *prima facie* case and shift the burden of going forward to the applicant."); *In re Latu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound.")

In the instant application, the Examiner states that it would have been obvious to combine elements from the references without providing any evidence of any suggestion, incentive, teaching, or motivation to do so. Thus, there is no *prima facie* case of obviousness of the claimed invention and the claims should be allowed. If the Examiner's statement is based on personal knowledge of a suggestion or incentive for this swap of elements, then Applicants respectfully submit that an Affidavit must be filed by the Examiner per M.P.E.P. § 2144.03.

The particular point of *Lee* to which Applicants call the Examiner's attention is that "common knowledge" is not an adequate basis for establishing a *prima facie* case of obviousness. The facts involved the combination of two references, neither of which disclosed or specifically suggested at least two salient features of the claimed invention. The Examiner had made conclusory statements, such as "the demonstration mode [\*12] is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper

Application No. 09/683,329

programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial." While the CAFC acknowledged that the Examiner and the Board are deemed to have experience in the field of the invention, they stated that the Examiner's conclusory statements did not adequately address the issue of motivation to combine and could be construed as hindsight reconstruction. In support of their decision, the CAFC indicated that whatever knowledge is to be applied must be articulated and placed on the record, and that evidence relied upon must be objective evidence of record; some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant must be present in the prior art and made of record.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In view of the foregoing amendments and remarks the subject application is believed to be in condition for allowance. Therefore, further consideration and allowance of the subject application is requested. If the Examiner considers personal contact advantageous to the disposition of this case, please call Applicants' Attorney, David E. Henn at (585) 423-4299, Xerox Corporation, Rochester, New York 14644, or fax him at (585) 423-5240.

Respectfully submitted,



David E. Henn  
Attorney for Applicants  
Registration No. 37,546

DEH/gmm

Application No. 09/683,329

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

[0057] Figure 6 shows a second seam structure embodiment that can beneficially be fabricated using the principles of the present invention. Like the first seam structure, this structure includes rabbeted tongues 34-24 and 36-26 that fit together to form a seam 11 such that the outer surface 30 and the inner surface 32 of the belt are substantially flush across the seam. However, in this embodiment the tongue 34-24 includes a protrusion 38 that fits into a channel 40. The tongues 34-24 and 36-26 not only increase the seam's surface area, thus enabling the adhesive 22 to form a stronger seam, but the protrusion 38 and channel 40 add a mechanical impediment to seam separation. Of course, the increased seam area along the protrusion 38 also improves the strength of the seam. The seam overlap configuration can again be bonded together to give a strong seamed belt, by either using an adhesive or ultrasonic welding technique as described in Figure 5.